## REMARKS

The above requested amendments to the claims are shown in bold type to make them easier to locate.

Applicants amended claim 1 in view of the restriction requirement so that the rings comprising $M^1$ and $M^2$ are each piperidinyl rings and $R^1$ is an indolyl group. That is, $M^1$ is amended to be N and $M^2$ is amended to be $C(R^3)$; the provisos relating to $M^1$ and $M^2$ are therefore unnecessary and are deleted, as are the two groups in the definition of Y that cannot be included when $M^1$ is N.

In the examiner's summary of the scope of claim 1, "n" was restricted to 2, "p" was 1 or 2, and "r" was 0-2, provided that the sum of r and p is 2. Applicants agree that to restrict the scope of the $M^1$-containing ring to piperidinyl, "n" must be restricted to 2, and the amendment reflects that. However, for the $M^2$-containing ring to be piperidinyl, the sum of p and r must be 3 (as indicated in the original restriction requirement), not 2 (as indicated in the recent office action). This can be achieved if p = 3 and r = 0, or if some combination of p + r = 3. Therefore, the amended claim 1 does not change the definition of "p" (i.e., it remains 1-3) but does restrict "r" to 0, 1 or 2, so that all possible piperidinyl rings are included.

In order to restrict $R^1$ to indolyl groups, the structures in the definition of $R^1$ having a nitrogen in the 6-membered ring are deleted, and the definition of "Q" is restricted to "$-N(R^8)-$". The definitions of k1 and k2 are unnecessary and therefore are deleted.

Additional obvious changes in punctuation, etc. were made in claim 1 in view of the amendments to the scope.

Claim 2 is amended to delete reference to $M^1$ and n, since the amendment to claim 1 restricts those variables to single definitions and no further limitation is imposed in claim 2.

In view of the finality of the restriction requirement limiting the claims to the method of treating congestion, claim 17 is amended to delete all other diseases. Claim 18 is canceled since it relates to a non-elected invention; claim 19 is canceled since it relates to a non-elected invention and is redundant in view of amended claim 17.

Claims 20 -24 are canceled in view of the restriction requirement.

Applicants reserve the right to file one or more divisional applications directed to the non-elected subject matter.

Claims 17-18 were rejected under 35 U.S.C. 112, second paragraph, for indefiniteness in the use of the term "allergy-induced airway responses." Since applicants have canceled claims 17 and 18 in view of the restriction requirement, thereby limiting the claims to the method of treating congestion (see page 2, 2nd and 3rd paragraph of the office action), it is urged that this rejection is rendered moot.

Claims 17-19 were rejected under 35 U.S.C. 112, first paragraph, for lack of enablement because of the number of diseases indicated to be treated and because of an alleged lack of a nexus between the compounds claimed and the treatment of congestion. The claims are said to be "reach through" claims because the methods of treatment are described as being the result of histamine $H_3$ antagonism.

Applicants urge that the claim to a method of treating congestion by administering a compound of claim 1 is not a "reach through" claim. Unlike the situations referred to in Baker Botts, where no compounds were identified and the claims referred only to a method of treatment accomplished by an unspecified compound binding to a certain receptor, applicants have identified a genus of compounds useful for treating specific diseases, including congestion. Histamine $H_3$ receptor antagonism is identified as the mechanism for the pharmacological activities listed in the specification, but the claims do not refer to the mechanism, only the diseases treated.

Applicants acknowledge that the claimed compounds are identified in the specification as histamine $H_3$ receptors. In further support of that, applicants enclose a declaration by inventor Robert G. Aslanian that demonstrates that besides Example 5 specifically identified in the specification, other compounds in the claimed genus bind to the histamine $H_3$ receptor and are receptor antagonists. (It is noted that the Guinea Pig Ileum Assay used to demonstrate receptor antagonism is reported in US 5,217,986, cited by the examiner.)

With respect to the state of the art, the fact that the indolyl compounds claimed by Henry et al treat congestion by alpha-2 adrenoreceptor agonism would not lead one skilled in the art to conclude that all indolyl compounds treat congestion by alpha-2

adrenoreceptor agonism; also, the fact that the Pomponi et al disclosures teach non-indolyl compounds acting as $H_3$ antagonists would not lead those skilled in the art to conclude that $H_3$ antagonists cannot be indolyl compounds. It is respectfully submitted that the references cited do not lead to the conclusion that indolyl derivatives cannot be $H_3$ antagonists, and in any case, the enclosed declaration demonstrates that the claimed compounds in the genus of formula I are $H_3$ antagonists.

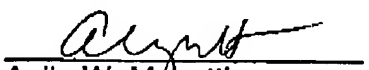
It is acknowledged that McLeod et al, CA 136:48247, cited in the rejection, indicates that a combination of a histamine $H_1$ antagonist and a histamine $H_3$ antagonist is effective to treat the nasal congestion associated with allergic rhinitis. However, the reference also states that an $H_1$ antagonist alone does not treat nasal congestion. Applicants urge, therefore, that it is not unreasonable or unbelievable to claim that an $H_3$ antagonist contributes to the treatment of nasal congestion, and applicants respectfully submit that they should be entitled to claim a method of treatment of congestion comprising the presently claimed compounds.

Reconsideration and withdrawal of the rejections under 35 U.S.C. 112 are respectfully requested.

Claims 1-14 and 16 were objected to because they contained non-elected subject matter, and claim 15 was objected to for being dependent on a rejected base claim. Applicants urge that with the above-requested amendments to the scope, the claimed subject matter is in compliance with the restriction requirement and the objections have been overcome. Reconsideration and withdrawal of the objections to claims 1-16 are respectfully requested.

Applicants confirm that no change in inventorship is required by the amendments made in view of the restriction requirement.

Respectfully submitted,



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